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GREENBLUM & BERNSTEIN PLC
1950 ROLAND CLARKE PLACE
RESTON VA 20191

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OFFICE OF PETITIONS

In re Patent No. 6,764,569	:	
Issue Date: July 20, 2004	:	
Application No. 09/744,149	:	DECISION ON PETITION
Filed: July 3, 1999	:	
Attorney Docket No. 225/49578	:	

This is a decision on the renewed petition under 37 C.F.R. §1.378(b) to accept the unavoidably delayed payment of the maintenance fee, filed September 6, 2011.

The petition under 37 C.F.R. § 1.378(b) is **GRANTED**.

Background

The above-identified patent issued on June 20, 2004. Accordingly, the first maintenance fee could have been timely paid during the period from June 20, 2007 through December 20, 2007, or with a late payment surcharge during the period from December 21, 2007 through June 20, 2008. No maintenance fee having been received, the patent expired on June 21, 2008.

In a petition filed on June 9, 2011, petitioner stated that there were three co-assignees of the instant application - DaimlerChrysler AG (hereinafter "Daimler"), Fraunhofer-Gesellschaft zur Forderung der angewanten Fourschung e.V. (hereinafter "Fraunhofer"), and Henkel KgaA (hereinafter "Henkel"). The three co-assignees had an agreement that while the application was pending, Daimler would be responsible for communicating with US counsel. Furthermore, after issuance, Daimler would remain responsible for tracking and paying the maintenance fees.

Petitioner stated that per the USPTO's PAIR system, on October 1, 2004, Dennemeyer & Co. Luxembourg was assigned the address for fee purposes (the "fee address" is the address to which the USPTO would mail any courtesy maintenance fee reminder). In May and June of 2005, Fraunhofer purchased Daimler's and Henkel's share in the invention, becoming the sole owner of the instant patent.

After the purchase was completed, Ms. Stephanie Lindner, an employee of Fraunhofer, undertook the task of instructing annuity service company Pavis to maintain the European patents for those that were purchased. However, Lindner did not enter the due dates in Fraunhofer's internal docketing system and did not inform Pavis of the instant US patent or of the dates for maintaining the instant patent.

The expiration of the instant patent was discovered in February of 2011, due to Fraunhofer's conducting a routine check of their database. Patentees filed the petition to accept the unavoidably delayed payment of the maintenance fee on June 9, 2011. However, the petition was dismissed in a decision mailed on July 5, 2011. The decision pointed out that it was not clear which party was responsible for paying the maintenance fee. The decision also explained that if Fraunhofer was the responsible party, then it was true that the failure of Lindner to enter the instant patent into Fraunhofer's tracking system may constitute unavoidable delay, provided employee error per MPEP 711.03(c) was properly shown.

Relevant Statutes and Regulations

35 U.S.C. § 41(c)(1) states that:

The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in §1.20(e) through (g);
- (2) The surcharge set forth in §1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Opinion:

With the instant renewed petition, petitioner has clarified that Fraunhofer was the party responsible for paying the maintenance fees. In addition, petitioner has established that: (1) Lindner's docketing error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (3) Lindner was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon Lindner represented the exercise of due care.

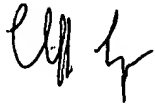
Conclusion:

Accordingly, it is concluded in this instance that petitioner has demonstrated that the delay in paying the 3.5 year maintenance fee was unavoidable.

The instant patent is hereby reinstated as of the mailing date of this decision.

Receipt of the \$400 fee for filing the request for reconsideration is acknowledged.

Telephone inquiries concerning this communication should be directed to the undersigned at 571-272-3207.

A handwritten signature in black ink, appearing to read 'Cliff Congo', with a stylized flourish at the end.

Cliff Congo
Petitions Attorney
Office of Petitions